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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/063,477	04/20/98	HOLTON R	FED-10302

000321 HM12/0628
SENNIGER POWERS LEAVITT AND ROEDEL
ONE METROPOLITAN SQUARE
16TH FLOOR
ST LOUIS MO 63102

TRINH, B EXAMINER

ART. UNIT PAPER NUMBER
1212

DATE MAILED: 06/28⁸99

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

09/063,477

Applicant(s)

HOLTON et al

Examiner

TRINH

Group Art Unit

1612

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Status

- ☒ Responsive to communication(s) filed on 6-7-99
- ☐ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- ☒ Claim(s) 1-45 is/are pending in the application.
- Of the above claim(s) 29-45 is/are withdrawn from consideration.
- ☒ Claim(s) 20-28 is/are allowed.
- ☒ Claim(s) 1-19 is/are rejected.
- ☐ Claim(s) is/are objected to.
- ☐ Claim(s) are subject to restriction or election requirement.

Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
 - ☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been received.
 - ☐ received in Application No. (Series Code/Serial Number) _____
 - ☐ received in this national stage application from the International Bureau (PCT Rule 1.7.2(a)).

*Certified copies not received: _____

Attachment(s)

- ☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 3-6
- ☐ Notice of Reference(s) Cited, PTO-892
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Interview Summary, PTO-413
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Other _____

Office Action Summary

Art Unit: 1612

Claims 1-45 are pending.

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-28 are drawn to a process of acylating C-10 hydroxy taxanes, classified in class 549, subclass 510.
- II. Claims 29-36, drawn to a process of converting the C-7 OH of taxane to an acetal or ketal, classified in class 549, subclass 510.
- III. Claims 37-45, drawn to taxane derivatives, classified in class 549, subclass 510.

The above delineated invention are distinct and separate because of their recognized divergent subject matter. They are drawn to distinct inventions because each one contains distinct subject matter which are not related one from another. A reference of one group would not suggest and/or render the other obvious in the absence of secondary teachings. Each group is capable of supporting a separate patent. Thus, the restriction requirement as indicated is deemed proper.

During a telephone conversation with Mr. Edward Hejlek on June 18, 1999 a provisional election was made with traverse to prosecute the invention of group I, claims 1-28. Affirmation of this election must be made by applicant in replying to this Office action. Claims 29-45 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

Art Unit: 1612

A person shall be entitled to a patent unless --

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371© of this title before the invention thereof by the applicant for patent.

Claims 1-19 are rejected under 35 U.S.C. 102(e) as being anticipated by claims 1-18 of

Damen et al. (US 5,874,595).

Claims 20-28 are allowable.

Any inquiry concerning this communication should be directed to Examiner Ba Trinh at telephone number (703) 308-4545.



BA K. TRINH
PRIMARY EXAMINER
GROUP 1200 1612

TRINH;mvw

06/23/99